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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,686	02/13/2004	Toshifumi Inno	0649-0943P	5883
2292	7590	09/16/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER

1752

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/777,686	Applicant(s) INNO, TOSHIFUMI	
	Examiner Barbara L. Gilliam	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-22 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1,3,4,6-13 and 15-22 is/are rejected.
 7) ☒ Claim(s) 14 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/8/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. The amendment filed June 15, 2005 have been entered and fully considered.
2. Claims 1, 3-4, 6-22 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 6-9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Independent claim 4 requires the presence of at least two reactive groups in the reactive group-containing hydrophobic compound and at least two vinyloxy groups. According to independent claim 1 and the specification the vinyloxy groups are reactive groups. It is not clear if Applicant is attempting to specifically define the two reactive groups as vinyloxy groups or if Applicant is requiring the presence of four reactive groups, two of which are vinyloxy groups.

- b. Claims 6-9 and 10 are dependent on claim 4.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 7, 11-13, 15-21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Maemoto (EP 1 132 200 A2).

a. The lithographic printing plate precursor of Maemoto comprises a hydrophilic support having a heat-sensitive layer coated thereon wherein the heat-sensitive layer contains either microcapsules containing a compound having a functional group capable of reacting by heat or a fine particulate polymer. When the heat-sensitive layer contains the microcapsules, it also contains a light-to-heat converting material (abstract; claims). The microcapsules may have a structure such that the microcapsules can react with each other, with the hydrophilic resin or the low molecular compound ([0042]). The microcapsule may contain compounds having thermally reactive groups such as an acrylate group, a methacrylate group, a vinyl group, an allyl group, an epoxy group, and compounds having at least one ethylenically unsaturated double bond ([0043]-[0057]; [0070]-[0086]). The low molecular compound having a functional group capable of reacting with the compound having a thermally reactive group contained in the microcapsules is used in an amount of from 5 to 40 wt% and includes the specific compounds having a thermally reactive group contained in the microcapsule ([0137]). The hydrophilic resin meets the present limitations for the same ([0115]-[0117]). The compound which initiates or accelerates the reaction of the microcapsule meets the present limitations for the same ([0118]-[0120]). A water-soluble overcoat layer may be provided on the heat-sensitive layer so

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as to prevent staining on the surface of the heat-sensitive layer due to lipophilic substances ([0149]). See Examples III-1 to III-14, IV-1 to IV-14.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 7, 11-13, 15-21 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Maemoto (EP 1 132 200 A2).

a. As pointed out in the rejection under 35 USSC 102(b), Maemoto teach a lithographic printing plate precursor comprising a hydrophilic support having a heat-sensitive layer coated thereon wherein the heat-sensitive layer contains either microcapsules containing a compound having a functional group capable of reacting by heat or a fine particulate polymer. When the heat-sensitive layer contains the microcapsules, it also contains a light-to-heat converting material. It would have been obvious to one of ordinary skill in the art to pick either the microcapsules or fine particulate polymer and any of the low molecular weight compounds taught therein including the specific combinations required by Applicant based on the overall teaching of Maemoto with reasonable expectation of obtaining a lithographic printing plate precursor with high sensitivity and long press life ([0002]).

Allowable Subject Matter

9. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

a. There is no teaching or suggestion in EP 1 132 200 A2 of at least two vinyloxy reactive groups in the low-molecular weight compound as required specifically in claim 14.

Response to Arguments

11. Applicant's arguments filed June 15, 2005 are considered but they are not persuasive.

a. Applicant argued that while Maemoto EP 1 132 200 A2 may generically disclose a large number of representative compounds for either the compound within the microcapsule or the hydrophilic resin or low molecular weight compound, Maemoto provides absolutely no guidance which would motivate one of ordinary skill in the art to select the specific combinations of reactive groups required by the present claims and that the anticipation rejection is unfounded due to the genus of possible combinations. The Examiner disagrees. Maemoto teaches that the microcapsules and low molecular compound can have various groups however, this teaching is with sufficient specificity. One of ordinary skill in the art could clearly envisage the combinations specifically required in the present application. MPEP 2131.02.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam
Barbara L. Gilliam
Primary Examiner
Art Unit 1752

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September 12, 2005